PATENT
Docket No. 232.00010101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Pulst et al.	)	Group Art Unit:	1818
Serial No.:	08/727,084	)	Examiner:	M.P. Allen
Filed:	October 8, 1996	)		
For:	NUCLEIC ACID ENCODING SPINOCEREBELLAR ATAXIA-2 AND PRODUCTS RELATED THERETO	)		

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 202331

Sir:

In response to the Restriction Requirement mailed June 19, 1997, applicants respectfully request consideration of the remarks that follow.

A. Restriction Requirement

The Examiner has made a restriction requirement under 35 U.S.C. § 121 of Claims 1-42 as pending in the above-referenced application into nine separate groups. Applicants provisionally elect, with traverse, to prosecute the claims of group I, Claims 1-14, 40 and 43. Applicants disagree with the Examiner's conclusion that the invention of Group 1 (drawn to nucleic acids encoding SCA2) is distinct from claims drawn to antisense oligonucleotides (Group II), or, for example, to methods for using the nucleic acids of Group I, such as those of Group IX.

The Examiner has not indicated that a separate class and subclass would be needed to search for Group IX, as compared to Group I. Moreover, the nucleic acids of Groups I and II fall into the same class. MPEP § 803 requires that the Examiner examine the application on the merits if the search and examination of an entire application, or a substantial part thereof, can be made without serious burden. Applicants do not believe that a search related to the claims of Group I, Group II and Group IX would create an undue burden for the Examiner. Applicants submit that in the field of molecular biology it would be difficult, if not impossible to search the literature for nucleic acid sequences to SCA2 without also searching the literature for the use of those sequences since the

literature for nucleic acid sequences would include uses of the sequences. Distinctiveness of invention based only on subclassifications is not enough on its own to establish separate inventions, particularly when the subclasses likely arose, not from separate searchable inventions, but as a method for handling the number of patent applications being prosecuted in this field.

For these reasons, Applicants submit that it is proper to examine the present application in its entirely, and at least proper to combine the claims of Groups I, II and IX. Applicants earnestly seek reconsideration of the restriction requirement in view of these comments.

Respectfully submitted,
PULST et al.
By their Representatives,
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August 19, 1997
Date

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